

REMARKS / ARGUMENTS

Status of Claims

Claims 1-23 are pending in the application. Claims 1-23 stand rejected. Applicant has amended Claims 1, 6, 15, 16, and 21, leaving Claims 1-23 for consideration upon entry of the present Amendment.

Applicant respectfully submits that the rejections under 35 U.S.C. §102(e) and 35 U.S.C. §103(a) have been traversed, that no new matter has been entered, and that the application is in condition for allowance.

Rejections Under 35 U.S.C. §102(e)

Claims 1, 2, 4 and 5 stand rejected under 35 U.S.C. §102(e) as being anticipated by Susil et al. (WO02/22015 hereinafter Susil).

Applicant traverses this rejection for the following reasons.

Applicant respectfully submits that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, *in a single prior art reference.*” *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). Moreover, “[t]he identical invention must be shown in as complete detail as is contained in the *** claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Furthermore, the single source must disclose all of the claimed elements “arranged as in the claim.” *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984). Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985).

Applicant has amended Claim 1 to now recite, *inter alia*,

“...stopping movement of the end effector when the person does not substantially have the predetermined respiratory state...”

No new matter has been added by this amendment as antecedent support may be found in the specification as originally filed, such as at Paragraph [0031] for example.

Dependent claims inherit all of the limitations of the respective parent claim.

In comparing Susil with the elements of Claim 1 as amended, Applicant finds Susil to disclose “The robot, or an attendant surgeon, can then drive the biopsy needle. Because the patient remains within the scanner, a single image will confirm that the needle has reached the target site.” [page 14, lines 15-16]. Here, Applicant finds Susil to disclose and teach a single action within a single image of driving the biopsy needle to its target site without stopping.

As such, Applicant submits that Susil is absent any disclosure of “moving the end effector along the trajectory path toward the target position when the person has substantially the predetermined respiratory state and stopping movement of the end effector when the person does not substantially have the predetermined respiratory state” as now recited in Claim 1.

Accordingly, Applicant submits that Susil does not disclose all of the claimed elements arranged as in the claim, and absent anticipatory disclosure in Susil of each and every element of the claimed invention arranged as in the claim, Susil cannot be anticipatory.

In view of the amendment and foregoing remarks, Applicant submits that Susil does not disclose each and every element of the claimed invention arranged as claimed and therefore cannot be anticipatory. Accordingly, Applicant respectfully submits that the Examiner’s rejection under 35 U.S.C. §102(e) has been traversed, and requests that the Examiner reconsider and withdraw of this rejection.

Rejections Under 35 U.S.C. §103(a)

Claims 3 and 6-23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Susil in view of Onik (U.S. Patent No. 4,583,538, hereinafter Onik).

Applicant traverses these rejections for the following reasons.

Applicant respectfully submits that the obviousness rejection based on the References is improper as the References fail to teach or suggest each and every element of the instant invention in such a manner as to perform as the claimed invention performs. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a *prima facie* case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Examiner must meet the burden of establishing that all elements of the invention are taught or suggested in the prior art. MPEP §2143.03.

Applicant has amended independent Claims 6, 15, 16, and 21 as set forth above to now recite elements also found in amended Claim 1.

Dependent claims inherit all of the limitations of the respective parent claim and any intervening claim.

In view of Applicant's remarks set forth above regarding the deficiencies of Susil in anticipating the invention of Claim 1, in view of amended Claims 6, 15, 16, and 21 now reciting elements similar to those of Claim 1, and in view of Susil being applied as the primary reference to reject Claims 6, 15, 16, and 21 under an obviousness rejection, Applicant submits that Susil fails to teach each and every element of the claimed invention arranged so as to perform as the claimed invention performs, and further submits that Onik fails to cure the deficiencies of Susil.

More specifically, Applicant submits that Susil and Onik are deficient in teaching moving the end effector along the trajectory path toward the target position when the person has substantially the predetermined respiratory state and stopping movement of the end effector when the person does not substantially have the predetermined respiratory state.

Applicant finds Onik to teach "Use of an immobilization device" [2:23-24] "thereby tending to fix the body's configuration [sic]" [8:40-41] "In this way all scans can be taken in the same phase of inspiration" [6:45-46].

Further, Onik teaches to "guide the needle or probe on the calculated course" [4:65-66], "Advancing the needle ...to just reach target 4' in the body" [5:20-22], "instrument will pass through the skin ...and reach said physical target point" [9:12-14],

and “pushing said instrument into the living body an amount equal to said calculated trajectory distance, so that said instrument ...reaches said physical target point” [10:1-4]

Applicant submits that Onik teaches immobilization of a patient and movement of a needle along a trajectory to reach a target point of the immobilized patient, and that such teaching by Onik is substantially different from and absent any teaching or suggestion of the now claimed *stopping movement of the end effector when the person does not substantially have the predetermined respiratory state.*

Accordingly, Applicant submits that the combination of Susil and Onik fail to teach each and every element of claims arranged so as to perform as the claimed invention performs, and therefore cannot support a *prima facie* case of obviousness.

In view of the foregoing, Applicant submits that the References fail to teach or suggest each and every element of the claimed invention and are therefore wholly inadequate in their teaching of the claimed invention as a whole, and disclose a substantially different invention from the claimed invention, and therefore cannot properly be used to establish a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests reconsideration and withdrawal of all rejections under 35 U.S.C. §103(a), which Applicant considers to be traversed.

In light of the foregoing remarks and amendments, Applicant respectfully submits that the Examiner’s rejections under 35 U.S.C. §102(e) and 35 U.S.C. §103(a) have been traversed, and that the application is now in condition for allowance. Such action is therefore respectfully requested.

If a communication with Applicant’s Attorneys would assist in advancing this case to allowance, the Examiner is cordially invited to contact the undersigned so that any such issues may be promptly resolved.

The Commissioner is hereby authorized to charge any additional fees that may be required for this amendment, or credit any overpayment, to Deposit Account No. 07-0845.

In the event that an extension of time is required, or may be required in addition to that requested in a petition for extension of time, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above-identified Deposit Account.

Respectfully submitted,

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October 30, 2007

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